

REMARKS

The Office Action dated September 26, 2007, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 3-8, 10-21, and 29-36 are currently pending in the application, of which claims 1, 13, and 36 are independent claims. Claim 13 has been amended to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 2, 9, and 22-28 have been cancelled without prejudice or disclaimer. Claims 1, 3-8, 10-21, and 29-36 are respectfully submitted for consideration.

Claims 8-9 were objected to as being substantial duplicates of one another. Claim 9 has been cancelled. Thus, this objection is moot, and its withdrawal is respectfully requested.

Claims 1-36 were rejected on the ground of non-statutory obviousness-type double-patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,788,676 (the '676 patent). The '676 patent is assigned to Nokia Corporation. The application that resulted in the '676 patent was filed on October 30, 2002. The present application, however, was filed February 13, 2002. According to MPEP 804(B)(1)(b), "[i]f the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by the patent is justified or unjustified must be addressed." The MPEP goes on to explain that a two-way test is to be applied when the applicant could not have filed the claims in a single application and there is administrative delay.

The Office Action does not establish that the applications could have been filed together and the lack of common inventors suggests that they could not have been filed together. Moreover, the more than three years that it took for the U.S.P.T.O. to issue a first Office Action in this application clearly qualifies as administrative delay. Because the record makes this delay clear, the Office Action is required to show either how the applications could have been filed together or how the claims of the '676 patent are obvious in view of the claims of the present application as well as how the claims of the present application are obvious in view of the '676 patent. The Office Action does not include any such analysis, accordingly the rejection is not a *prima facie* rejection and should be withdrawn.

Furthermore, this same issue was previously brought to the USPTO's attention in previous response and in the Pre-Appeal Brief Request for Review filed July 2, 2007. MPEP 707.07(f) sets forth the Examiner's obligation to answer all material traversed. Specifically MPEP 707.07(f) states that "the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." It is essential that the Office Action address each of the arguments presented by Applicant, so that meaningful appellate review is possible. The Office Action, however, does not address the arguments previously presented on this issue. Accordingly, the rejection is incomplete, and it is respectfully requested that the rejection be withdrawn.

Claims 1-36 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Office Action took the position

that the subject matter of the claims was not described in the original specification in a manner so as to convey that the inventors had possession of the invention at the time the application was filed. Applicants respectfully traverse this rejection, as applied to the claims still pending in the application. Claims 2, 9, and 22-28 have been cancelled without prejudice or disclaimer. Thus, the rejection of claims 2, 9, and 22-28 is moot, and should be withdrawn.

The Office Action stated that “Independent claims recite, “providing secure access to said packet data network based on said protection processing”. Even though instant specification discloses “secure network access can be provided without using additional fields in the messages ...” [see Summary, paragraph 0014], details of providing such secure (network) access has not been disclosed in the details [sic] description.” This rationale fails to support the rejection, because it does not establish a *prima facie* case for lack of possession.

As MPEP 2163(I)(A) states, “There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed.” *See also, In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims”).

Furthermore, as MPEP 2163(III)(A) indicates, lack of possession should be established by the Office Action by first identifying the specific limitation and then

establishing a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention.

Whether or not the Office Action's factual allegations are true (not admitted), a failure to disclose the details of providing such secure network access in no way suggests that the inventors were not in possession of the concept. As MPEP 2161(I) indicates, "The function of the written description requirement is to ensure that the inventor had possession of, as of the filing date of the application relied on, the specific subject matter later claimed by him or her; **how the specification accomplishes this is not material.**" (emphasis added) *See In re Herschler*, 591 F.2d 693, 700-01, 200 USPQ 711, 717 (CCPA 1979); *In re Kaslow*, 707 F.2d 1366, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983); and *see also* MPEP § 2163 - § 2163.04. Thus, support is not the issue, and possession is certain because the concept is described in the specification as originally filed, as admitted by the Office Action. Thus, it is respectfully requested that the rejection be withdrawn.

Claims 1, 2, 4-9, 13, 15-21, 23-28, and 36 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the independent claims recite: "deriving a second source information" and do not "clearly point out where this second source information is derived from." The Office Action suggested including the features of claim 3 in all of the independent claims. Applicants respectfully traverse this rejection, as applied to the claims still pending in the application. Claims 2, 9, and 22-28 have been

cancelled without prejudice or disclaimer. Thus, the rejection of claims 2, 9, and 22-28 is moot, and should be withdrawn.

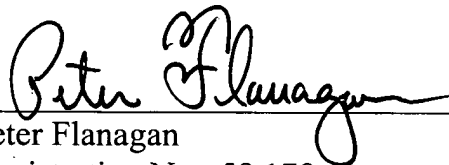
The Office Action has clearly conflated **breadth** with indefiniteness. The Federal Circuit has recently explained that the standard for indefiniteness is that the claim is “insolubly ambiguous.” *Invtrogen Corp. v. Biocrest Manufacturing, L.P.* (Fed. Cir. Oct. 5, 2005); see also MPEP 2173.05(e). In the present application, however, there is nothing ambiguous: the place from which the source information is derived is simply not recited. Thus, the claim is broad, not indefinite. Furthermore, one example is provided in claim 3, as the Office Action recognized. Thus, one of ordinary skill in the art would be able to determine the metes and bounds of the invention without claim 3 being inserted into claim 1. Accordingly, it is respectfully requested that the rejection be withdrawn.

There were no rejections on the basis of alleged prior art. Accordingly, for the reasons set forth above, it is respectfully submitted that each of claims 1, 3-8, 10-21, and 29-36 is definite and recites subject matter that was possessed by the inventors at the time the application was filed. It is, therefore, respectfully requested that all of claims 1, 3-8, 10-21, and 29-36 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants’ undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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